REMARKS

Claims 1-6 and 10-19 are pending in this application. Claims 1, 5, 12, 14 and 17 have been amended. Claims 8, 9 and 20 have been cancelled. Claims 1, 12 and 17 are independent claims.

In an Office action dated August 14, 2006, it was noted that prior remarks filed by Applicants were considered, but were deemed to be moot in view of new grounds of rejection. In accordance with the new grounds of rejection, claims 1-6 and 9-11 were rejected under 35 U.S.C. 102(e) as being anticipated by O'Toole, Jr. et al. (hereinafter "O'Toole"). The remaining pending claims were rejected under 35 U.S.C. 103(a). Applicants respectfully point out that the rejections under Section 103(a) are not clearly stated. As a consequence, Applicants will proceed on the basis of assumptions regarding the combination of prior art references. Claims 8 and 12-20 were rejected under Section 103(a) over O'Toole in view of Duke et al. (hereinafter "Duke"). In the rejection of independent claim 12, there is a reference to Abdelhadi-Shrader, but Abdelhadi-Shrader is cited for being different than the claimed invention, rather than cited for teachings that correspond to the claimed invention. Applicants submit that the citation of Abdelhadi-Shrader is merely an inadvertent carryover from the prior Office action.

In response to the new grounds of rejection, Applicants amend independent claims 1, 12 and 17 to more clearly distinguish the claimed invention from the cited prior art. Moreover, selected independent claims have been amended. The amended claims more clearly describe the invention in terms of its solution to problems set forth in the application as originally filed. As described in paragraphs [0002], [0003] and [0004] of the application, the latency in downloading requested files is reduced by the use of proxies, but the concern is that this also results in a less reliable count of "hits" in the accessing of a network file. The claimed invention addresses this concern by triggering the transmission of a "count-inducing message" from a receiving device each time a network file is received at the device, so that a Web site administrator can more accurately track the total number of hits for the network file (paragraph [0012]). Independent claim 1 has been amended to refer to the environment in which the invention provides an advancement in

the art. Claim 1 states that the reception of a request for the network file from the requesting device occurs at a proxy, which forwards the request to an originating server when the cache memory of the proxy does not include a cached copy of the requested network file. Similarly, independent claims 12 and 17 refer to the originating servers and the proxies. Dependent claim 9 has been cancelled in order to eliminate redundancy between amended claim 1 and original claim 9. Because this feature was originally contained in the description of claim 9, Applicants assert that the application as filed supports the amendments to the independent claims.

Claim 1 was previously amended to state that the instruction embedded within the network file to transmit the indicator is an instruction that is transparent to an end-user of the requesting device. Independent claims 12 and 17 have been amended to include a similar description. Claim 12 now states that the instruction triggers user-transparent transmissions of count-inducing messages, while claim 17 states that the programming is configured to transmit the identifier in a process that is transparent to the users upon reception of one of the network files. Moreover, each independent claim now states that the transmission is with respect to a count-inducing message.

Applicants assert that the amendments to the claims patentably distinguish the claimed invention from the combination of teachings of the prior art references. Reconsideration is requested.

A. Rejection Based upon 35 U.S.C. 102

Independent claim 1 and dependent claims 2-6 and 9-11 were rejected under 35 U.S.C. 102. As has been established, a *prima facie* case of anticipation under Section 102 is not established, even though elements of the claims are known in the prior art, if the elements are not arranged in the prior art in the manner required in the claims. Ex parte Gould, 6 USPQ2d 1680 (P.O.Bd.Ap. 1987). Applicants assert that as described in amended claim 1, less than all of the elements of the claimed method are described in O'Toole and those elements that are described in O'Toole are not set forth in the claimed sequence.

In the rejection of claim 1, certain features are cited as being anticipated by description in columns 9 and 10 of O'Toole, while other features are cited as being anticipated by teachings within columns 11 and 12 of O'Toole. This applies to dependent claims as well. Applicants assert that the process described in columns 9 and 10 of the patent is fundamentally different than the process described in columns 11 and 12. These two processes described in O'Toole relate to different problems, are directed to different goals, and provide different solutions. Moreover, whether taken alone or in combination, these two processes of O'Toole do not anticipate the claimed invention.

The problem addressed in columns 9 and 10 of O'Toole relates to the restriction of exchange of personal information regarding an individual. The personal information within a security profile is sent to a requesting server only if certain conditions are met. Applicants respectfully point out an error in the interpretation of the teachings of O'Toole, as provided in the Office action rejection under Section 102. In the Office action, it is alleged that the "receiving" step of claim 1 is anticipated by O'Toole, which teaches that a client computer requests a profile. However, as taught by O'Toole, it is the client computer that receives the request for the profile. Located at the client computer is a client "avatar" that acts as an agent for the user by controlling the release of information from the client personal profile to the requesting server computer (O'Toole: column 9, lines 31-34). If the profile query from the server computer requests restricted information, the client avatar located on the client computer determines if the requesting server is "trusted" and, if so, checks an authentification signature. If the avatar determines that information from the profile can be released, all or a subset of the information within the profile is sent to the requesting server (O'Toole: column 10, lines 4-38). On the basis of the transferred information, the server transmits a client-specific sales offer or a customized document to the client computer. The server may use the subset of client personal information to customize other web-based services offered to the user, including digital coupons.

As compared to the process described in columns 9 and 10 of O'Toole, the process described in columns 11 and 12 is unrelated to restrict-

ing the transfer of a profile to another computer, is not directed to the goal of maintaining security, and provides a different solution to a different problem. In the portions of columns 11 and 12 cited in the Office action, the problem is ensuring that a user at a client computer is properly billed when the client computer "obtains valuable web-based information." For billing purposes, a metering log is maintained at the client computer to record occurrences of obtaining valuable web-based information. In column 12, lines 24-38 of O'Toole, it is stated that the client computer periodically transmits the contents of the metering log to another computer which enters the information into detailed billing records. If the client computer accesses particularly valuable information, the applet activated by the client computer may require the client computer to transmit the contents of the metering log immediately, so as to prevent the client user from re-initializing the client computer and erasing its metering logs.

Because the process described in columns 9 and 10 is fundamentally different than the process described in columns 11 and 12 of O'Toole, Applicants assert that a *prima facie* case of anticipation under Section 102 is not established by selectively combining features of the different processes. When referring to the first process (the profile security process of columns 9 and 10 in O'Toole), the method of claim 1 is not anticipated, since there is no description of transmitting an indicator from a requesting device as an automated response to executing an instruction embedded within a network file, where the indicator is a count-inducing message that is specific to the network file in which it is embedded. Moreover, there is nothing within the teachings of columns 9 and 10 of O'Toole that anticipates counting the indicator at the location to which the indicator is transmitted for updating a tally of the hits of the network file. Columns 9 and 10 of O'Toole are unrelated to counting hits or providing a tally. Rather than determining the number of times a network file is accessed, columns 9 and 10 relate to limiting access to personal profile information.

On the other hand, the cited portions of columns 11 and 12 of O'Toole relate to identifying when a network file is accessed. However, this process does not anticipate the method described in amended claim 1. A number of embodiments are described in these two columns of O'Toole. As

one major embodiment, the network file with the embedded active link is received at the client computer and is visible to the user. This embodiment is described in column 11, lines 34-46. An embedded active link may be a hyperlink that permits a user to navigate easily among documents by allowing the user to activate the hyperlink in a first document to obtain a second document. "The retrieval of the second document can be implemented by the same applet that is used for the metering function." Thus, the count-inducing message (indicator) of O'Toole is not transmitted as a direct response to receiving the first document. Similarly, the count-inducing message of O'Toole is not transmitted as a direct response to receiving the second document, since the metering function is triggered in unison with the request for retrieval of the second document.

In other embodiments, the embedded active link within the first document is called by the browser (O'Toole: column 11, line 60 to column 12, line 38). This is the embodiment cited in the Office action. However, the "metering function" of O'Toole is implemented at the client computer. As seen in Fig. 7, the metering log (302) is contained within the client computer (300). The metering log is not a "count-inducing message that is specific to the network file," as set forth in claim 1. The patent states that in this embodiment in which the active link is an embedded image, the sole practical function of the activation of the active link is to cause the client computer to activate the applet for metering the user's access to information (O'Toole: column 12, lines 7-10). The applet may record click activity on the transparent embedded image and then pass the click activity onto other objects in the document, thereby capturing detailed usage information that is stored in the metering log, such as the number and location of clicks. This does not anticipate the sequence of steps of claim 1.

Additionally, the metering log of O'Toole is not used to update a tally of hits of the network file, where the tally is representative of both sending the network file from a proxy and sending the network file from the originating server. Rather, when the metering log of O'Toole is transmitted, it is used for billing purposes with respect to the user at the particular client computer from which the metering log was transmitted.

A person of ordinary skill in the art would readily recognize that a "metering log" is not specific to a particular item until the identification of the item is entered. Therefore, O'Toole does not anticipate transmitting an indicator (metering log) from a requesting device as an automated response to executing an instruction as a direct consequence of receiving a network file. In O'Toole, any counting of the clicks by the metering log occurs at the client computer.

In view of the amendments to claim 1, it is respectfully asserted that the claim is patentably distinguishable from the teachings of O'Toole. Therefore, claim 1 and its dependent claims are in an allowable condition. Reconsideration is requested.

B. Rejection Based upon 35 U.S.C. 103

Independent claim 12 was rejected under 35 U.S.C. 103(a) over O'Toole in view of Duke. The Office action cites column 3, lines 10-30, of O'Toole for teaching a method of counting a number of accesses for cachable documents. These lines teach that the metering log which records activations resides at the client computer. Thus, the tally occurs at the client computer. The metering log is transmitted to the server computer, but O'Toole teaches that this process is to make it possible "to charge a user on a per-usage basis for the user's access to information." Thus, the counting is specific to a single client computer.

With respect to the claim 12 feature of embedding executable code in cachable documents, where the executable code includes an instruction triggering transmissions of count-inducing messages from the client devices, the Office action cites column 6, lines 32-67 of O'Toole. O'Toole teaches a number of different "aspects." The different aspects are individually identified in the portion of the patent entitled "SUMMARY OF THE INVENTION." The description in column 6 of O'Toole is unrelated to the metering log aspect. Column 6 relates to coupons. The patent states that a coupon-providing server may send a document to a client computer containing an embedded digital coupon. The coupon may be an executable program or program fragment expressed in machine-executable form. These coupons

are for the purpose of offering an opportunity for purchase. This is inconsistent with the teachings regarding the aspect of a metering log, which is used to charge a user on a per-usage basis for the user's access to information. Moreover, the description of the coupons in column 6 of O'Toole is inconsistent with the amended description of claim 12, which states that the executable code embedded within a cachable document includes an instruction triggering user-transparent transmissions of count-inducing messages. Persons of ordinary skill in the art would not interpret the coupon presentation of column 6 in O'Toole to be one which suggests activity that is user-transparent.

Claim 12 has also been amended to state that each count-inducing message is specific to and indicative of a particular cachable document. The coupons described in column 6 of O'Toole do not include embedded executable code that includes an instruction triggering transmission of a count-inducing message. On the other hand, the metering log of columns 3 and 11 of O'Toole is not a count-inducing message that is specific to and indicative of a particular said cachable document of a plurality of cachable documents. Rather, the metering log is contained on the client computer and is responsive to recording access of any number of different documents.

The Office action cites Duke for updating a tally. The stated basis for concluding that it would be obvious to a person of ordinary skill in the art to modify the O'Toole apparatus on the basis of Duke is, "Doing so would prevent exposure to loss of orientation while maintaining high data integrity." Applicants respectfully request clarification. It is respectfully asserted that nothing within the teachings of the two prior art references indicates that the apparatus of O'Toole is susceptible to loss of orientation. Applicants assert that loss of orientation is irrelevant to the apparatus of O'Toole. Because of loss of orientation is irrelevant to the teachings of O'Toole, there is no motivation for modifying the O'Toole apparatus as proposed in the Office action.

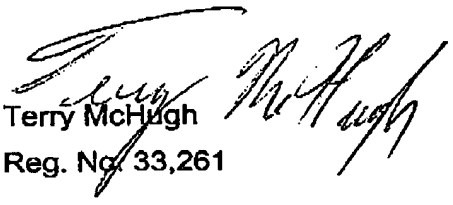
Claim 13 states that the method of independent claim 12 includes receiving one of the count-inducing messages for each cachable document received by the client devices. Lines 1-8 in column 11 of O'Toole

are cited as being relevant. However, the metering log described in these lines is not document-specific. That is, the metering log may log a number of different cachable documents.

Regarding independent claim 17, the claim was rejected as containing the same limitations as set forth in claim 12, so that the same rationale is to be applied. As with claim 12, Applicants agree that O'Toole does not teach the updating of a tally in the manner described in the claims. Rather, O'Toole teaches using a metering log, which is distinguishable from the counting of receptions of identifiers so as to update a tally of transfers of network files to a plurality of client devices. As with claim 12, Applicants assert that a person of ordinary skill in the art would find no relevance between the teachings of O'Toole and possibilities of "exposures to loss of orientation," so that the motivation stated in the Office action for modifying O'Toole in view of Duke does not satisfy the requirements of a *prima facie* case of obviousness under Section 103(a).

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,



Terry McHugh
Reg. No. 33,261

Date: November 10, 2006

Telephone: (650) 969-8458
Facsimile: (650) 969-6216